

Remarks

Applicant has reviewed the Office Action dated as mailed January 30, 2006 and the documents cited therewith. After the above amendments have been made, the present application contains claims 1-14 and 16-27. Claims 1, 3, 4, 9, 13, 19, 20, 22, 25, and 27 have been amended.

Claim Rejections Under 35 U.S.C. §112

Claim 19 was rejected 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 19 has been amended to more particularly point out and distinctly claim the subject matter of the present invention, and reconsideration and withdrawal of the rejection of claim 10 under 35 U.S.C. §112 is respectfully requested.

Claim Rejections under 35 U.S.C. §102

Claims 1-2, 5-7, 13-14, 16-21, and 25-26 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,963,640 to Manning (hereinafter Manning). This rejection is respectfully traversed. Claim 1 has been amended to recite:

“determining in a device whether a digit or a wild card has been entered in the device by a user after each entry forming at least a portion of a complete telephone number until a first digit is entered by the user;
searching any telephone numbers stored in the device to form a match list including any stored telephone numbers matching a sequence of digits and wild cards entered by the user in response to the user entering the first digit...”

In contrast, Manning in column 4 beginning at line 12 recites:

“For example, as illustrated in FIG. 3, the user initially dials the number 1 212 345 xxxx. Based on that sequence, the system selects an appropriate long distance carrier and that carrier has associated with it a sequence 1010789 which replaces the prefix 1 in the final dialing sequence 50.”

And Manning in column 8 lines 1-11 recites:

“A flow chart of the basic overall operation of the dialer is provided in FIG. 7. Referring again to FIG. 6, considering that a user dials the digits “1-212-345-xxxx” on a telephone set that is connected to the dialer. The microprocessor 42 receives the dial telephone number

and stores the first digit in a temporary memory location (Step 655). A software program running on microprocessor 42 retrieves the prefix "1" from that memory location and compares it with the prefixes stored in the prefix table (Step 660). When a matching prefix is detected at 662, the information stored in the corresponding prefix table entry is processed (Step 665)."

Accordingly, Manning in contrast to the present invention as recited in the claims teaches that the user dials a complete telephone number and that a prefix in the complete number dialed by the user is used to compare to entries in a prefix table. The prefix table entries define an action descriptor for indicating how the telephone number should be processed in a table look up to determine the dialing sequence (see the Abstract of Manning). Applicant respectfully submits that Manning does not teach or suggest determining whether a digit or a wild card has been entered in a the device by a user after each entry forming at least a portion of a complete telephone number until a first digit is entered by the user and searching any telephone numbers stored in the device to form a match list including any stored telephone numbers matching the sequence of digits and wild cards entered by the user in response to the user entering the first digit (emphasis added). Manning teaches that a complete telephone number is entered by the user and then only a prefix is compared to a prefixes in a prefix table not stored telephone numbers.

Additionally, Manning in column 5 lines 15-19 recites:

"FIGS. 4A and 4B illustrate the data structure of each entry of the prefix table. Each entry begins with a prefix such as 1 or 011. To allow a variable length prefixes not limited by field length the end of each prefix is indicated by a punctuation mark F."

And Manning in column 5 lines 27-30 recites:

"In addition to being definable by any number of the twelve dialable digits, prefixes in the table are also defined by nondialable digits C, D and E."

And Manning in column 5 lines 38-40 recites:

"In matching a prefix, a match on a string without wild card characters C or D has priority over a match on a string with wild card characters included."

Accordingly, Manning teaches that the wild cards are entries in a prefix table and are not entered by the user. Further, Manning does not teach or suggest that the wildcards form at least a portion of a complete telephone number but rather provide dialing instructions for selecting a long distance carrier. Additionally, Manning in column 6 lines 28-46 recites:

“A table descriptor code of 4 indicates a prefix table entry structure of FIG. 4B. The table descriptor code is followed by a nibble M, a 3-nibble Start-address and a 3-nibble End-address. M determines how many digits after the prefix should be used to try to match one of the entries in a Compact Long Distance (CLD) Table 56 starting Start-address. If the Prefix Table entry indicates a value of M as 3, for instance, the LCD Table has a number of entries packed together, with each entry being a candidate 3-nibble string to compare to the user’s string, plus an ensuing nibble to specify the Long-Distance Table index should there be a match. Wildcards X and N may be included in the final digit(s) for cases where less than M digits control.”

Applicant respectfully submits that the wildcards X and N are entries in a Compact Long Distance table and are not wildcards entered by a user forming at least a portion of a complete telephone number as provided by the present invention as recited in claim 1. Additionally, as discussed above and as clearly shown in Figures 3, 5 and 6 of Manning, Manning’s process of selecting a long distance carrier is not performed until after the user has entered a complete telephone number. There is no teaching or suggestion in Manning of determining in a device whether a digit or a wildcard has been entered in the device by a user after each entry as provided by the present invention as recited in claim 1. Furthermore, since Manning teaches that a complete telephone number is entered by the user, there is no teaching or suggestion in Manning of determining in the device whether another digit or another wildcard has been entered in the device by the user after each additional entry as provided by the present invention as recited in claim 1.

To further emphasize Manning’s failure to teach or suggest the present invention as recited in claim 1, Figure 3 of Manning clearly shows a complete telephone number 48 that has been entered by the user. Since Manning is only concerned with routing long distance calls the x’s after the 3-digit local exchange merely represent the local number served by the exchange and are not wildcards. Figure 3 of Manning then illustrates that the completely dialed number is used to enter a prefix table 54, long distance (LD) pointer tables 56 and a long distance carrier table 52 to provide a sequence of numbers 50 which are prefixed to the dialed telephone number 48 for selecting a long distance carrier. Accordingly, Manning also does not teach or suggest forming a match list based on telephone numbers stored in the device nor does Manning teach or suggest searching the previous match list to form a new match list including any telephone numbers matching a current sequence of digits and wildcards entered by the user in response to a last entry by the user being a digit, as provided by the present invention as recited in claim 1.

For all of the reasons discussed above, Applicant respectfully submits that claim 1 is patentably distinguishable over Manning. Reconsideration and withdrawal of the 35 U.S.C. §102 rejection of claim 1 is respectfully requested.

Turning now to the rejection of claims 2 and 5-7 under 35 U.S.C. §102(e) has being anticipated by Manning, these claims contain additional features which further patentably distinguish over Manning. These claims recite displaying a match list or displaying each match list in a predetermined order. As discussed with respect to claim 1, Manning does not teach or suggest forming a match list after each entry by a user that is a digit as provided by the present invention as recited in the claims. Moreover, Manning in column 5 lines 22-26 recites:

“When a dialed telephone is received the processor compares each of the prefixes in the prefix table to the initial digits of the dialed number to locate a match. If no match is found, the dialed number is passed through as a final dialing sequence without modification.”

Applicant respectfully submits that there is no teaching or suggestion in Manning of displaying each match list as provided by the present invention as recited in claim 2.

Manning in column 5, lines 51-53 recites:

“D. candidates which have the same length but wild cards at different positions are ordered according to which wild card appears latest thus, 12C45C comes before 1C345C.”

When reading this portion of Manning in context with the remainder of Manning, the candidates referred to are entries in a prefix table that define an action descriptor for indicating how a telephone number should be processed in a table look up to determine the dialing sequence (Abstract of Manning). Accordingly the candidates are not telephone numbers in a match list, and while Manning may teach that they are ordered according to which wild card appears latest, there is no teaching or suggestion in this section of Manning that they are displayed to a user, rather they are ordered to prioritize a long distance dialing sequence according to which long distance carriers may be preferred over others because of better pricing or other criteria (see Manning column 4 lines 26-34). Therefore, claim 5 is submitted to be patentably distinguishable over Manning.

Manning in column 6 lines 39-46 recites:

“Wildcards X and N may be included as the final digits for cases where less than M digits control. For example, if the compact table is used for country codes, which vary in length of two or three digits, two digit codes would be followed by a wildcard. The “addresses” or

candidate nibble strings in this table should be in numeric order based on the first digit then the second digit, etc., to minimize search time.”

Reading this portion of Manning in context with the remainder of Manning, the numbers referred to are addresses or candidate nibble strings in a Compact Long Display (CLD) table 56 and not telephone numbers for subscribers as defined by the present invention as recited in the claims. Additionally, while Manning may teach placing these addresses or candidate nibble strings in the table in numeric order to minimize search time, there is no teaching or suggestion that these addresses are displayed to a user. Therefore, claim 6 is submitted to be patentably distinguishable over Manning.

Applicant respectfully submits that Manning in column 7, lines 27-36 does not teach or suggest displaying a new match list in response to a new match list being formed as provided by the present invention as recited in claim 7. Therefore, claim 7 is also submitted to be patentably distinguishable over Manning.

Moreover, claims 2 and 5-7 depend directly from independent claim 1. By virtue of this dependency, these claims contain all of the features of independent claim 1. For all of the reasons discussed above, claims 2 and 5-7 are submitted to be patentably distinguishable over Manning, and reconsideration and withdrawal of the 35 U.S.C. §102 rejection of claims 2 and 5-7 is respectfully solicited.

Turning now to the rejection of independent claim 13 under 35 U.S.C. §102(e) as being anticipated by Manning, claim 13 has been amended to recite:

“receiving in a device a first entry by a user;
receiving an additional entry from the user, if the first entry is a wildcard;
repeating receiving an additional entry from the user until a digit is received;
searching any stored telephone numbers to form a match list including any of the stored telephone numbers with a digit in a first position and higher order positions in a sequence of digits forming each stored number...”

In contrast, Manning in column 8, lines 1-11 as recited above teaches that a user dials a complete telephone number on a telephone set that is connected to the dialer. A software program then retrieves the prefix of the dialed number and compares it with entries in a prefix table as previously discussed. Applicant respectfully submits that there is no teaching or suggestion in Manning of continuing to receive additional entries from a user if the first entry is a wildcard and

repeating receiving additional entries from the user until a digit is received. Manning also does not teach or suggest searching any stored telephone numbers to form a match list including any of the stored telephone numbers with a digit in a first position and higher order positions in a sequence of digits forming each stored number because Manning teaches that the user enters a complete telephone number without any wild cards and then searches a prefix table not stored telephone numbers as provided by the present invention as recited in claim 13.

Claim 13 has also been amended to recite:

“searching the match list for telephone numbers matching a sequence of entered digits and wildcards after receiving each additional entry from the user that is a digit forming at least a portion of a complete telephone number.”

As discussed above Manning teaches matching a prefix of a complete telephone number entered by a user to entries in a prefix table that define an action descriptor for indicating how the telephone number should be processed in a table look up to determine the dialing sequence (Abstract of Manning). Thus, Manning does not teach or suggest searching the match list for telephone numbers matching a sequence of entered digits and wildcards after receiving each additional entry from the user that is a digit forming at least a portion of a complete telephone number as provided by the present invention as recited in amended claim 13 (emphasis added).

For all of these reasons, claim 13 is submitted to be patentably distinguishable over Manning. Reconsideration and withdrawal of the Section 102 of claim 13 is respectfully solicited.

Regarding the rejection of claims 14 and 16-19 under 35 U.S.C. §102(e) as being anticipated by Manning, these claims recite additional features which further patentably distinguish over Manning. Additionally, these claims depend either directly or indirectly from independent claim 13. Because of that dependency claims 14 and 16-19 contain all of the features of independent claim 13. Accordingly, claims 14 and 16-19 are submitted to be patentably distinct over Manning, and reconsideration and withdrawal of the 35 U.S.C. §102 rejection of these claims is respectfully requested.

Turning now to the rejection of independent claim 20 under 35 U.S.C. §102(e) as being anticipated by Manning, claim 20 contains features similar to independent claims 1 and 13. Specifically, claim 20 has been amended to recite:

“a processor to search any stored telephone numbers in response to receiving at least one digit or a sequence of digits and wildcards from a user to form at least a portion of a

complete telephone number, and to form a match list in response to any stored numbers matching the at least one digit or sequence of digits in wild cards;... means for searching the match list for telephone numbers matching a sequence of entered digits and wild cards after receiving each additional entry from the user that is a digit forming at least a portion of a complete telephone number.” (emphasis added)

As previously discussed, Manning teaches receiving a complete telephone number and then comparing a prefix of that telephone number to entries in a prefix table to determine a prefix to be added to the telephone number for selecting a particular long distance carrier for particular reasons such as reduced cost. Accordingly, Manning does not teach or suggest a processor to search any stored telephone numbers in response to receiving at least one digit or sequence of digits and wildcards from a user to form at least a portion of a complete telephone number, nor does Manning teach or suggest means for searching the match list for telephone numbers matching a sequence of entered digits and wildcards after receiving each additional entry from the user that is a digit forming at least a portion of a complete telephone number. The wildcards in Manning are entries in a Compact Long Distance table and are not wildcards that are entered by a user. As clearly shown in Figures 3, 5 and 6 and as described in Manning the user enters a complete telephone number and not a telephone number that contains a sequence of digits and wildcards as provided by the present invention as recited in independent claim 20. Therefore, Applicant respectfully submits that independent claim 20 is patentably distinguishable over Manning, and reconsideration and withdrawal of the 35 U.S.C. §102 rejection of claim 20 is respectfully requested.

Regarding the rejection of claim 21, claim 21 recites a display to display the match list. As previously discussed, Manning does not teach or suggest displaying a match list as provide by the present invention as recited in the claims. Additionally, claim 21 depends directly from independent claim 20. By virtue of that dependency, claim 21 contains all of the features of claim 20. Accordingly, claim 21 is submitted to also be patentably distinguishable over Manning and reconsideration and withdrawal of the Section 102 rejection of claim 21 is respectfully solicited.

Regarding the rejection of independent claim 25 under 35 U.S.C. §102(e) as being anticipated by Manning, independent claim 25 recites similar features to independent claims 1 and 13. For example, claim 25 recites:

“searching the match list for telephone numbers matching a sequence of entered digits and wildcards after receiving each additional entry from the user that is a digit forming at least a portion of a complete telephone number.”

As previously, Manning does not teach or suggest searching the match list for telephone numbers matching a sequence of entered digits and wild cards after receiving each additional entry from the user that is a digit forming at least a portion of a complete telephone number. Therefore, Applicant respectfully submits that claim 25 is patentably distinct over Manning, and reconsideration and withdrawal of the Section 102 rejection of claim 25 is respectfully requested.

With respect to the rejection of claim 26 under 35 U.S.C. §102(e) as being anticipated by Manning, claim 26 recites displaying the match list. As previously discussed Manning does not teach or suggest displaying a match list or matches of a prefix in a prefix table. Additionally, claim 26 depends directly from independent claim 25. Because of that dependency, claim 26 contains all of the features of claim 25. Therefore, claim 26 is submitted to also be patentably distinguishable over Manning and reconsideration and withdrawal of the Section 102 rejection of claim 26 is respectfully requested.

Claim Rejections Under 35 U.S.C. §103

Claims 3, 8, 11-12 and 23-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Manning in view of U.S. Patent 5,864,603 to Haavisto et al. (hereinafter Haavisto). This rejection is respectfully traversed. Applicant respectfully submits that this rejection under 35 U.S.C. §103 does not follow the M.P.E.P. § 706.02(j) which states:

“After indicating that the rejection is under 35 U.S.C. §103, the examiner should set forth in the Office Action:...(B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification... the teach or suggestion to make the claimed combination and the reasonable expectation of the success must both be found in the prior art and not based on applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

As discussed in detail below, Applicant respectfully submits that there is no teaching or suggestion in Manning or Haavisto that their teachings may be combined so as to provide the present invention as recited in the claims and such motivation only comes from Applicant’s disclosure. This approach constitutes impermissible hindsight and must be avoided. As previously discussed, Manning teaches a telephone dialer that includes tables for determining a dialing sequence for a long distance carrier. In contrast, Haavisto teaches a method and apparatus for

controlling a telephone with voice commands. There is no teaching or suggestion in Manning or Haavisto or in the Office Action how the voice command method and apparatus of Haavisto would be combined with the table searching features of Manning so as to select a low cost long distance carrier to complete a telephone call.

Even if it were proper to combine the teachings of Manning and Haavisto, they still would not provide the present invention as recited in the claims. Claims 3, 8, and 11-12 recite additional features which further patentably distinguish over Manning and Haavisto. Additionally, claims 3, 8 and 11-12 depend either directly or indirectly from independent claim 1, and by virtue of that dependency contain all of the features of claim 1. Applicant respectfully submits that Haavisto adds nothing to the teachings of Manning so as to render independent claim 1 unpatentable. Therefore, Applicant respectfully submits that claims 3, 8, and 11-12 are also patentably distinguishable over Manning and Haavisto, whether considered individually or combined, and reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of claims 3, 8 and 11-12 is respectfully requested.

Turning now to the rejection of claims 23-24 under 35 U.S.C. §103(a) as being unpatentable over Manning in view of Haavisto. As previously discussed, combining the teachings of Manning and Haavisto would not be proper under M.P.E.P. § 706.02(j). Even if it were proper to combine Manning and Haavisto, they still would not provide the present invention as recited in claims 23 and 24. These claims contain additional features which further patentably distinguish over Manning and Haavisto. Additionally, claims 23 and 24 depend either directly or indirectly from independent claim 20, and as result of that dependency contain all of the features of claim 20. Applicant respectfully submits that Haavisto adds nothing to the teachings of Manning so as to render independent claim 20 unpatentable. Therefore, claims 23 and 24 are also submitted to be patentably distinguishable over Manning and Haavisto, whether considered individually or combined, and reconsideration and withdrawal of the Section 103 rejection of these claims is respectfully solicited.

Allowable Subject Matter

Claims 4, 9-10, 22, and 27 were objected to as being dependent upon a rejected base claim, but were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim in any intervening claims. Pursuant to the Examiner's suggestion, claims 4, 9, 22, and 27 have been rewritten in independent form including all of the features of the

base claim and any intervening claims. Claim 10 depends directly from amended claim 9 and therefore contains all of the features of claim 9. Accordingly, these claims are submitted to be patentably distinct over the documents of record in the present application, and reconsideration and withdrawal of the objection to these claims is respectfully requested.

Conclusion

For the foregoing reasons, the Applicant respectfully submits that all of the claims in the present application are in condition for allowance. Reconsideration and withdrawal of the rejections and allowance of the claims at the earliest possible date are respectfully solicited.

If the Examiner has any questions about the present Amendment or anticipates finally rejecting any claim of the present application, a telephone interview is requested.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-4365.

Respectfully submitted,

Karin Spalink
(Applicant)

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By: Charles L. Moore
Charles L. Moore
Registration No. 33,742

Moore & Van Allen, PLLC
P.O. Box 13706
Research Triangle Park, N.C. 27709
Telephone: (919) 286-8000
Facsimile: (919) 286-8199